

## **REMARKS**

By this Amendment, Applicant cancels claims 2, 9, 12, and 13, without prejudice or disclaimer of the subject matter thereof and amends claims 1, 3, 6-8, and 10 to more appropriately define the present invention. Claims 1, 3-8, 10, and 11 are currently pending.

In the Office Action mailed May 13, 2004, the Examiner rejected claims 1-4, 6-10, 12, and 13 under 35 U.S.C. § 102(b) as anticipated by United Kingdom Patent No. 2311910A to Robinson et al. (hereinafter "Robinson"); and rejected claims 5 and 11 under 35 U.S.C. § 103(a) as unpatentable over Robinson in view of U.S. Patent No. 6,704,813 to Smirnov et al. (hereinafter "Smirnov"). Applicant respectfully traverses the Examiner's rejections.

### **Regarding Claim Rejection under 35 U.S.C. § 102**

Applicant respectfully traverses the Examiner's rejection of claims 1-4, 6-10, 12, and 13 under 35 U.S.C. § 102(b) as anticipated by Robinson. To anticipate Applicant's claimed invention under 35 U.S.C. § 102, each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989), emphasis added.

Claims 1 and 6, as amended, recite combinations including, for example, "second communication means for establishing a second radio channel with the base station and making communications over the second radio channel simultaneously with the first communication means." Robinson fails to disclose at least "second

communication means for establishing a second radio channel with the base station and making communications over the second radio channel simultaneously with the first communication means,” as required by amended claims 1 and 6.

Robinson teaches “a modular radio communication device, wherein different modules provide access to different radio communication services.” Robinson, page 3, lines 16-18. “Upon adding or deleting modules to and from the radio communication unit, the radio communication system reconfigures the channel providing radio communication services to the radio communication unit.” Robinson, page 3, lines 19-22, emphasis added. “For example, if the communication will only involve voice communications, then the bandwidth assigned may be 9.6 kilobits/second. If the communication will involve voice and video communications, then the bandwidth assigned may be 64 kilobits/second.” Robinson, page 7, lines 16-20, emphasis added. However, merely changing the bandwidth of an assigned channel , as taught by Robinson, does not constitute a teaching of “second communication means for establishing a second radio channel with the base station and making communications over the second radio channel simultaneously with the first communication means,” as required by amended claims 1 and 6.

Therefore, Robinson fails to disclose each and every element of claims 1 and 6. Robinson thus cannot anticipate Applicant’s claimed invention recited in claims 1 and 6. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1 and 6. Since claims 3 and 4 depend on claim 1, and claim 7 depends on claim 6, Applicant also requests withdrawal of the rejection of claims 3, 4, and 7 for at least the same reasons stated above.

Independent claim 8, while of different scope, recites similar language as in claim 1. Claim 8 is therefore allowable for at least the same reasons stated above.

Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 8 and claim 10, which depends on claim 8. Since claims 2, 9, 12, and 13 have been canceled, the rejection of claims 2, 9, 12, 13 is therefore moot.

### **Regarding Claim Rejection under 35 U.S.C. § 103**

Applicant respectfully traverses the Examiner's rejection of claims 5 and 11 under 35 U.S.C. § 103(a) as unpatentable over Robinson in view of Smirnov. In order to establish a prima facie case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143, emphasis added.

Claims 5 and 11 depend on claims 1 and 8, respectively. As explained above, Robinson fails to teach or suggest at least "second communication means for establishing a second radio channel with the base station and making communications over the second radio channel simultaneously with the first communication means," as required by amended claim 1.

Smirnov fails to cure Robinson's deficiencies. Smirnov discloses a system for storing streaming information. "Streaming information can be received by computer 20 using a number of known methods and technologies. Commonly, a source of streaming information is a remote computer wherein computer 21 is connected to the remote

computer using a wired or wireless modem.” Smirnov, column 4, lines 51-55. However, Smirnov does not suggest or teach at least “second communication means for establishing a second radio channel with the base station and making communications over the second radio channel simultaneously with the first communication means,” as required by amended claim 1.

Therefore, neither Robinson nor Smirnov, taken alone or in any reasonable combination, teaches or suggests all claim elements recited in claim 1. A prima facie case of obviousness cannot be established regarding claim 1. Claim 1 is therefore nonobvious over Robinson in view of Smirnov. Since claim 5 depends on claim 1, claim 5 is also nonobvious for at least the same reasons stated above. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 5.

Claim 8, while of different scope, recites similar language as in claim 1. Claim 8 is therefore also nonobvious over Robinson in view of Smirnov for at least the same reasons stated above. Since claim 11 depends on claim 8, claim 11 is also nonobvious over Robinson in view of Smirnov. Accordingly, Applicant also requests withdrawal of the rejection of claim 11.

### **Conclusion**


In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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